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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,703	07/26/2001	Byeung-Joon Ahn	P/2292-46	9357
2352	7590	07/09/2004	EXAMINER	
OSTROLENK FABER GERB & SOFFEN			CIRIC, LJILJANA V	
1180 AVENUE OF THE AMERICAS			ART UNIT	
NEW YORK, NY 100368403			PAPER NUMBER	

3753

DATE MAILED: 07/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/915,703	Applicant(s) AHN, BYEUNG-JOON	
	Examiner Ljiljana (Lil) V. Ciric <i>LVC</i>	Art Unit 3753	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/5/2004, 2/6/2004, 9/8/2003, 6/2/2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-23 is/are pending in the application.
- 4a) Of the above claim(s) 6-12 and 17-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,13-16 and 20-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/30/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This Office action is in response to the amendments and arguments filed on April 5, 2004, February 6, 2004, September 8, 2003, and June 2, 2003.

Response to Arguments

2. Applicant's arguments with respect to claims 1, 3 through 5, 13 through 16, 20, 21, and 23 have been considered but are moot in view of the new grounds of rejection presented herein.

Applicant's arguments filed on September 8, 2003, and June 2, 2003 with regard to claim 22 have been fully considered but they are not persuasive.

The following traversal of applicant's arguments is prefaced hereby with the examiner hereby noting that the claims in a pending application should be given their *broadest* reasonable interpretation. See In re Pearson, 181 USPQ 641 (CCPA 1974).

Applicant first argues that "No cylindrical body is transformed into a square-shaped body in the Takayama, et al. reference", and that therefore "there cannot be 'anticipation'" of the instant invention. Then applicant proceeds to state that the Takayama et al. reference indeed does describe a process for manufacturing a chip inductor in which kneaded material in the form of powdered magnetic material and a binder are fed under pressure to a primary extruder, whereby this initial process produces a winding core or bar-body with a circular cross-section, with a conducting wire being subsequently wound by a winding device "around the circular, bar-like body". Thus, since a "bar-like body" with a circular cross-section is, by definition, a cylindrical body, the applicant appears to admit that the Takayama et al. reference indeed discloses and anticipates a cylindrical body as recited in claim 22. Applicant then goes on to state that Takayama et al. furthermore discloses the bar-like (i.e., cylindrical body) with the coil winding as being fed to a secondary extruder in which the cylindrical body is coated by another kneaded

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material, which then passes through a generally square-shaped extruder. Thus applicant furthermore admits that the cylindrical body is *transformed* into a coated square-shaped body by passing the cylindrical body through a square-shaped extruder which applies the coating which transforms the cylindrical body into a coated square-shaped body as broadly interpreted as required.

Further in response to applicant's argument that the Takayama et al. references fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the *reshaping* of an initially cylindrical or round solid body into a square-shaped body) are not recited in rejected claim 22, for example. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant's arguments thus fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Applicant's arguments thus do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

Election/Restrictions

3. Claims 6 through 12 and 17 through 19 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to non-elected species or inventions, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on November 4, 2002.

Specification

4. Receipt and entry of the amended abstract is hereby acknowledged.
5. Receipt and entry of the substitute specification is hereby acknowledged.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1, 3 through 5, 13 through 16, 10, 21, and 23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. For example, base claim 1 as amended now newly recites forming a metal layer on the surface of the cylindrical body and then forming a coil pattern as a spiral shape on the metal layer, yet nothing in the originally filed disclosure relating to the elected species as depicted in Figure 6C supports claiming the forming of a coil pattern on the metal layer. New claim 23 recites a hollow cylindrical body as being reshaped, but there is no support for a hollow cylindrical body being reshaped as now claimed. Thus, these newly recited limitations represent new matter.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 3, 14, and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3 and 14 are still not in proper Markush format, and furthermore it is not clear how the selection is to be made from the elements listed. For example, with regard to claim 3, it is not clear whether the metal layer is to include at least one element from the group including Ag, Al, Au, Pt, Ni, Cu, Pd, and Sn and to additionally include a metal alloy including at least one of Ag, Al, Au, Pt, Ni, Cu, Pd, and Sn, OR whether the metal layer is to include at least one of element from the group including Ag,

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Al, AU, Pt, Ni, Cu, Pd, Sn, and metal alloys including at least one of Ag, Al, Au, Pt, Ni, Cu, Pd, and Sn, thereby rendering indefinite the metes and bounds of protection sought by the claim. The limitations following "comprises" in claim 14 are also not clearly stated, and are, at the very least, redundant, and thus not clear (i.e., "comprises *at least one of a group of elements in the group consisting of*").

With regard to claim 23 as written, there is insufficient antecedent basis for the limitation "the hollow cylindrical body" as cited in lines 5 and 6 of the claim, it not being clear whether this limitation is intended to refer back to the tubular cylindrical body as recited in line 2 of the claim or to some other cylindrical body, thus rendering the metes and bounds of protection sought unclear. Furthermore, it is not clear whether the "cylindrical hollow body" recited in line 7 is referring back to the same hollow cylindrical body as recited in lines 5 and 6 of the claim (if so, recommend inserting "the" or "said" in front of the limitation "cylindrical hollow body"). Finally, it is not clear whether the limitation "the cylindrical body" as recited in line 7 of the claim refers back to the "cylindrical hollow body" as recited in line 7, to the "hollow cylindrical body" as recited in each of lines 5 and 6, or to the "tubular cylindrical body" as recited in lines 2 and 3 of the claim.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claim 22 is rejected under 35 U.S.C. 102(b) as being anticipated by Takayama et al. (previously of record and previously applied).

Takayama et al. [especially see Figures 1B, 1C or 3A, 3B in combination with Figure 2] discloses a method of manufacturing a chip inductor essentially as claimed, including forming a cylindrical body by mixing a ferrite with a thermoplastic organic binder, forming a coil pattern on the

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surface of the cylindrical body 8 by winding a conducting wire 10 around the cylindrical body 8, transforming the cylindrical body 8 into a square-shaped body 13 by inserting the cylindrical body 8 into a square-shaped extruder 11.

The reference thus reads on the claims.

12. The non-application of art against claims 1, 3 through 5, 13 through 16, 20, 21, and 23 should not be construed as an indication that the claims contain allowable subject matter but rather that the patentability of the claims cannot be established at this time due to indefiniteness and/or other problems (such as new matter) under 35 U.S.C. 112, first and second paragraphs.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ljiljana (Lil) V. Ciric, whose telephone number is (703) 308-3925. While she works a flexible schedule that varies from day to day and from week to week, Examiner Ciric may generally be reached at the Office during the work week between the hours of 10 a.m. and 6 p.m. ET.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Scherbel, can be reached on (703) 308-1272.

The NEW central official fax phone number is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0861.

A handwritten signature in cursive script, appearing to read "Ljiljana Ciric".

**LJILJANA CIRIC
PRIMARY EXAMINER**